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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,376	08/05/2003	Michael Peter Corby	C7520 A US	6930

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EXAMINER	
JOHNSON, JERRY D	

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/634,376	CORBY ET AL.	
	Examiner	Art Unit	
	Jerry D. Johnson	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 17-72 is/are pending in the application.

4a) Of the above claim(s) 35-72 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 17-34 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/619,261.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 17-34, drawn to a method for a lubricating conveyor belt surface and a lubricated conveyor belt, classified in class 198, subclass 500.

II. Claims 35-40, drawn to a liquid composition, classified in class 508, subclass 208.

III. Claims 41-72, drawn to a method for lubricating a conveyor belt surface, classified in class 198, subclass 500.

The inventions are distinct, each from the other because of the following reasons:

Inventions group II and groups I & III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as in a process of metal working or lubricating a mold.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the particular lubricant of the subcombination. The subcombination has separate utility such as lubricating a conveyor belt surface wherein the lubricant is continuously applied.

Because these inventions are distinct for the reasons given above Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Jim Sales on February 17, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 17-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 35-72 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-29, 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Montgomery.

Montgomery, U.S. Patent 4,162,347, teaches a conveyor treating composition comprising from about 0.05 to about 2 percent by weight dimethyl polysiloxane, with the

balance consisting substantially of water soluble components comprising (A) a water soluble polyhydroxy compound or monoalkyl ether thereof, and (B) a water soluble organic nonvolatile compound having at least one hydrophilic group, compound (column 2, lines 44-53). Typical component (A) compounds are ethylene glycol, di-ethylene glycol, triethylene glycol, propylene glycol, di-propylene glycol, glycerine and sugar. Of these materials, at least a major proportion of ethylene glycol is preferred. The monoalkyl ethers, such as monobutyl ether of ethylene glycol are also useful (column 3, lines 31-40). Preferably, the polysiloxane is of the type having a kinematic viscosity of at least about 100,000 centistokes. Such compounds are commonly available commercially as aqueous emulsions, e.g., as Dow Corning HV-490 emulsion (aqueous, 35% active polysiloxane). The addition of water to the treating composition is generally undesirable. However, so long as the total amount of water present in the treating composition prior to use does not exceed about 5 percent by weight, the effect of the small amount of water added by the siloxane emulsion is negligible (column 4, lines 20-33). While Montgomery does not teach that the conveyor belt "is used for the transport of containers", that recitation is an intended use which doesn't limit the lubricated conveyor belt. Accordingly, claims 27-29, 32 and 34 are anticipated.

Claims 17-20, 22-24, 26-30 and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Gutzmann.

Gutzmann, U.S. Patent 5,174,914, teaches aqueous lubricant compositions and more particularly lubricant compositions compatible with synthetic polymeric packaging materials, such as polyethylene terephthalate (PET), linear high density polyethylene (LHDPE), polystyrene, and the like. Such lubricant compositions are adapted for use as a

lubricating agent on the load bearing surfaces of a chain driven conveyor system used for conveying such synthetic polymeric materials (column 1, lines 8-16). The lubricant composition comprising a fatty acid diamine salt (column 2, lines 35-52). The lubricant composition may also include various optional components intended to enhance lubricity, microbial efficacy, physical and/or chemical stability, etc. (column 2, lines 57-60), including, inter alia, polyhydric alcohols and anionic surfactant (Column 5, lines 1-4, lines 19-22, lines 49-66; column 6, lines 4-20, lines 53-61). The lubricating compositions may also contain those components conventionally employed in conveyor lubricant compositions, which are compatible in the composition, to achieve specified characteristics such as anti-foam additives, viscosity control agents, perfumes, dyes, corrosion protection agents, etc. (column 6, line64 to column 7, line 2). In Table Two of Gutzmann, lubricant compositions comprising a silicone emulsion defoamer (Mazu DF210), anionic surfactant and polyethylene glycol are disclosed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20, 23-33 and 35 of

copending Application No. 09/619,261. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 09/619,261 application claims a method for lubricating a conveyor belt surface comprising applying a liquid lubricant composition comprising silicone oil, water, polyhydric alcohol and anionic surfactant. Accordingly, while not of the same scope, the claims of the 09/619,261 teach a method of lubricating a conveyor surface which renders the instantly claimed conveyor surface and method of lubricating a conveyor surface, comprising applying a liquid composition to a conveyor belt surface, the liquid composition comprising a silicone oil and an aqueous phase and a compound selected from the group consisting of polyhydric alcohols, surfactants and mixtures thereof, obvious to one having ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (571) 272-1448. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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